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_	APPLICATION NO.	PPLICATION NO. FILING DATE		FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	_
	10/807,348 03/24/2004 23373 7590 05/04/2005		Kosuke Takasaki	Q80473	5375		
				EXAM	EXAMINER		
	SUGHRUE	•			ISAAC, STANETTA D		
	2100 PENNS SUITE 800	SYLVAN	IIA AVENUE, N.W.		ART UNIT	PAPER NUMBER	
	WASHINGTON, DC 20037				2812		_

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)					
	10/807,348	TAKASAKI ET AL.					
Office Action Summary	Examiner	Art Unit					
	Stanetta D. Isaac	2812					
The MAILING DATE of this communication app Period for Reply	ears on the cover sheet with the c	orrespondence address					
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).							
Status							
1) Responsive to communication(s) filed on 24 Ma	Responsive to communication(s) filed on 24 March 2004.						
2a) This action is FINAL . 2b) ⊠ This							
3) Since this application is in condition for allowan	3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is						
closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.							
Disposition of Claims							
4)⊠ Claim(s) <u>1-22</u> is/are pending in the application.	· ·						
4a) Of the above claim(s) is/are withdraw	vn from consideration.						
5) Claim(s) is/are allowed.							
6) Claim(s) is/are rejected.							
7) Claim(s) is/are objected to.							
8) Claim(s) 1-22 are subject to restriction and/or e	election requirement.						
Application Papers							
9) The specification is objected to by the Examiner	•						
10)☐ The drawing(s) filed on is/are: a)☐ accepted or b)☐ objected to by the Examiner.							
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).							
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).							
11) The oath or declaration is objected to by the Ex	aminer. Note the attached Office	Action or form PTO-152.					
Priority under 35 U.S.C. § 119	•	•					
12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of: 1. Certified copies of the priority documents have been received.							
2. Certified copies of the priority documents have been received in Application No							
3. Copies of the certified copies of the prior	• •						
application from the International Bureau (PCT Rule 17.2(a)).							
* See the attached detailed Office action for a list of the certified copies not received.							
		fully					
		NNE A. GURLEY					
Attachment(s)		RY PATENT EXAMINER					
1) Notice of References Cited (PTO-892)	4) ∭ Interview Summary (
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)	Paper No(s)/Mail Da 5) Notice of Informal Pa	te atent Application (PTO-152)					
Paper No(s)/Mail Date	6) Other:						
0.0							

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DETAILED ACTION

Election/Restrictions

- Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-16, drawn to a method, classified in class 438, subclass 118.
 - II. Claims 17-22, drawn to a device (product-by-process), classified in class 257, subclass 1+.

The inventions are distinct, each from the other because of the following reasons:

- 2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by a materially different process, such as a process which does not "require sticking a transfer member, to which the adhesive is applied, to the spacer" rather, the adhesive could be applied directly to the spacer.
- 3. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Although it is noted that the claims 17-20 are product-by-process claims, product-by-process claims are directed to the product not matter how actually made. *In re Taylor*, 149 USPQ 615, 617 (CCPA 1966). Consequently, it is the patentability of the final product, and not the patentability of the process, that must be determined in a product-by-process claim. *In re*

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Thorpe, 227 USPQ 964,966 (CAFC 1985), Ex parte Edwards 231 USPQ 981, 983 (BdPatApp&Int 1986).

4. A telephone call was made to Darryl Mexic on 4/19/05 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stanetta D. Isaac whose telephone number is 571-272-1671. The examiner can normally be reached on Monday-Friday 9:30am -6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Lebentritt can be reached on 571-272-1873. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Stanetta Isaac Patent Examiner April 19, 2005

LYNNE A. GURLEY

PRIMARY PATENT EXAMINER TC 2800, AU 2812